



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/238,405 05/05/94 CAPON

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FOSTER CITY, CA 94404

18N2/0607

D CELL 53
EXAMINER

ALLEN, M

ART UNIT PAPER NUMBER

9

1812
DATE MAILED:

06/07/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined *for restriction purposes only* ☐ Responsive to communication filed on ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 6 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-56 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☐ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-56 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-37 and 55-56, drawn to chimeric DNA encoding membrane bound proteins and the proteins, classified in at least Classes 530 and 536, subclasses 350 and 23.4, respectively.

II. Claims 38, drawn to methods of activating cells, classified in at least Class 514, subclass 2, for example.

III. Claims 39-45, drawn to a method for producing cells, classified in at least Class 435, subclass 172.3, for example.

IV. Claims 46-54, drawn to a method of treating a disease, classified in Class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and (II-IV) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the protein or DNA of group I could be used in each of the methods of groups II-IV.

The methods of groups II-IV are distinct, each from the other, because they have different steps, goals, and/or starting materials. Each method would require a non-coextensive literature search.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the necessity for non-coextensive literature searches, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Karen Krupen on 05 June 1995 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition

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under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen, whose telephone number is (703) 308-0666. The examiner can normally be reached on Monday-Thursday from 8:00 am to 5:30 pm. The examiner can also be reached on alternate Fridays.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Garnette D. Draper, can be reached on (703) 308-4232. The most convenient FAX telephone number for Art Unit 1812 is (703) 308-0294.

15 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Marianne P. Allen
MARIANNE P. ALLEN
PATENT EXAMINER
GROUP 1800